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Docket No. 03-03 US

REMARKS

By advisory action mailed July 12, 2007 the Examiner declined to enter amendments offered in response to the Office Action mailed April 26, wherein claims 1-4, 6-15 stand rejected under §102(b) and separately under §102(a/e) and claims 3 and 13 are rejected per section 103 as discussed below. Claims withdrawn consequent to a previous requirement for election are reproduced in full. Amendment to claims is here presented and entry of the amendment is requested to narrow any issues raised in previous stages of prosecution.

"New Issues"

In his Advisory Action, the Examiner declined to enter amendments to the claims as "raising new issues". Limitations introduced at that time for claim 1 and here repeated, are directed (in paraphrase and without quotation) to

the application of the amorphous composition of stated magnetic susceptibility to an NMR instrument, and

the more precise statement of such magnetic susceptibility achieving, at cryogenic temperatures, a "first value" equal to the magnetic susceptibility of the environment of the sample.

With respect to the first matter, the specification is express at

p.1, lines 4-6

p.2, lines 12-15

p.3, lines 12-27

p.5, lines 1-3; 26-28, etc.

In respect to the second general area of amending limitation, see the specification at

p.4, lines: 13-23

p.6, lines: 18-22 ("zero value"); 23-31 ("selected value"), etc.

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Rejections per §102

In respect to the Final Action, claims 1-2, 4, 7-12 and 14-15 were again rejected on Halverson, US patent 3,377,292, of record, pursuant to §102(b).

Applicant first refutes the Examiner's paragraph 2 of that Action as directed to claim 11 as a stark demonstration of error in ignoring a required quantitative limitation of the claim.

Claim 11 requires that the composition

“...has a nearly zero magnetic susceptibility at said cryogenic temperatures.”

It has escaped the Examiner's attention that claim 11 requires a *quantitative* limitation expressed in absolute terms in contrast to the relative limitation of claim 1. Moreover that quantitative property is required at “said cryogenic temperatures”. The reference is completely silent on the matter of the most importance here, yet the Examiner holds that because the reference composition is “similar” the magnetic susceptibility properties (quantitatively expressed herein!) will be inherent in the prior art composition. That assertion is utterly without foundation. Applicant requests the withdrawal of the rejection directed to claim 11 and the dependencies thereon.

In regard to claim 1, the proposed amendment seeks to state a more exact prescription for the “selected” value of magnetic susceptibility. To that end, the context for the composition is stated and it is the value of magnetic susceptibility *of the environment* surrounding the sample (P.2, lines 6-21; P.3, lines 7-16) to which the magnetic susceptibility of the composition is compared for substantial equalization “at cryogenic temperatures”.

Claims 1-3 and 7-10 were rejected on section 102(b) citing Cheng, of record. The Examiner refused to consider the use of the composition in magnetic resonance apparatus because he considered that such context did not result in a structural difference. The Examiner has not considered the structural difference in magnetic resonance apparatus owing to the magnetic susceptibility properties of the composition. As presently amended, the context presents a *quantitative* property for measuring the limitation on magnetic susceptibility of the composition.

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The Cheng reference has no relevance to the magnetic properties of Cheng's composition nor the temperature range applicable. The Examiner has simply asserted that the compositions are substantially identical and (apparently by PTO practice) therefore they will exhibit substantially the same magnetic susceptibility (an astounding conclusion). The basis for such procedural pronouncement is given as

"When the PTO shows a sound basis for believing that products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not."
(citations)

Applicant has met such burden, *ab initio*, through disclosures evidenced by figures 1 and 2 and relevant text.

The Examiner comments that even if Cheng is insufficient to establish anticipation, it would be "obvious to one of ordinary skill in the art to optimize the properties of the Gd complex as choice of its use in magnetic imaging characteristics with reasonable expectations of success." If the prior art presents no quantitative measure of magnetic susceptibility and no indication of the temperature dependence of same, there is not even an initiation of the kind of predictability that might be a starting point for the obviousness that the Examiner asserts. Accordingly, the assertion of obviousness fails.

Rejections per §103

The Examiner attacks claims 3 and 13 on section 103(a) with references to Halverson and Zheng in combination. These claims depend from claims 1 and 11 and should be allowed for that reason.

Claims 7-9, dependent from claim 1 have been amended due to removal from claim 1 of the nomenclature "selected" value of magnetic susceptibility.

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Conclusion

Amendment has been proposed to more precisely limit the subject matter of this work. The matter of "new issues" raised by the Advisory Action has been discussed. Applicant has expressed claim limitations directed to the magnetic susceptibility of the composition while the Examiner has previously ignored these limitations without regard to any temperature limitation. The amendments here submitted are intended to more fully narrow the issues prevailing in this prosecution. No new matter has been offered. The amended claims are believed properly in condition for allowance and such action is respectfully requested.

Respectfully submitted,



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